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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,144

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Jeffrey A. Tilton

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2790 COLUMBUS ROAD  
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EXAMINER

PIZIALI, ANDREW T

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/789,144	<b>Applicant(s)</b> TILTON ET AL.	
	<b>Examiner</b> Andrew T. Piziali	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-13,15,38-40 and 42-62 is/are pending in the application.
- 4a) Of the above claim(s) 38-40,42-46,48-51,57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-13,15,47,52-56 and 59-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/27/04 & 10/23/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species 1 of Species Group I, and Species 1 from Species Group II, in the reply filed on 11/14/2007 is acknowledged. The traversal is on the grounds that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. This argument is persuasive for Species Group II. Therefore, said species restriction is withdrawn. This argument is not found persuasive for Species Group I because the species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

In addition to previously withdrawn claims 57 and 58, claims 38-40, 42-46 and 48-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species from Species Group I.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 52-56 and 59-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Although the specification discloses (page 8, lines 21-26) that ribs may be cut from a blanket of cubes of fibrous material (as shown in Figure 4) to form the ribs (shown in Figure 3), the specification is silent regarding cubed ribs. The ribs of Figure 3 are clearly not cube shaped and the specification does not teach or suggest that the ribs cut from a blanket of cubes of fibrous material results in ribs that possess cubes or resemble a cube in any way.

4. Claims 52-56 and 59-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is silent regarding how to make a blanket of cubes of fibrous material (Figure 4).

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 52, 55, 56 and 59-62 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,892,187 to Patrick.

Patrick discloses a liner/insulator comprising a base layer of fibrous material and a plurality of cubed, fibrous ribs extending from and bonded to said base layer (see entire document including the Figures and column 4, lines 52-67).

In the event that it is shown that the applied prior art does not disclose the claimed embodiment with sufficient specificity, the invention is obvious because the prior art specifically discloses the claimed constituents.

Regarding claim 55, Patrick discloses that the base layer and said plurality of ribs are formed of polyester and/or glass fibers (column 4, lines 5-13).

Regarding claims 56 and 61, Patrick discloses that the ribs extend parallel to one another and are grouped in sets (see Figures).

Regarding claim 59, Patrick discloses that the ribs may be made of scrap fibrous material (column 2, lines 47-53).

Regarding claim 60, Patrick discloses that the base layer is tuned to provide improved acoustical properties (column 4, lines 5-13) and the plurality of ribs inherently provide strength to said liner/insulator.

Regarding claim 62, Patrick discloses that the base layer is a uniform base layer (see Figures).

### ***Claim Rejections - 35 USC § 103***

8. Claim 1, 3-5, 8-13, 15, 47, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,892,187 to Patrick as applied to claims 52, 55, 56 and 59-62 above, and further in view of USPN 5,885,390 to Alkire.

Patrick discloses that the base layer and said plurality of ribs are formed of polyester and/or glass fibers (column 4, lines 5-13), but Patrick does not appear to mention specific glass fibers.

Alkire discloses that it is known in the acoustical and thermal insulation art to include glass staple bicomponent fibers to reduce cost, process with less effort, and/or improve performance characteristics (see entire document including column 1, line 10 through column 2, line 42 and column 7, lines 5-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include glass staple bicomponent fibers, motivated by a desire to reduce cost, process with less effort, and/or improve performance characteristics, and

because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

A patent for a combination, which only unites old elements with no change in their respective functions, obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men. Where the combination of old elements performed a useful function, but it added nothing to the nature and quality of the subject matter already patented, the patent failed under §103. When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious. **KSR v. Teleflex.**

Regarding claim 3, Patrick discloses that the base layer and said plurality of ribs are formed of polyester and/or glass fibers (column 4, lines 5-13).

Regarding claims 4 and 8, Patrick discloses that the width of the ribs may be about 22 mm or less (0.87 inches or less) and illustrates a distance between the ribs about equal to the specifically mentioned rib width (column 5, lines 44-57 and Figures 1-3).

Regarding claim 5, Patrick discloses that the ribs extend parallel to one another (see Figures).

Regarding claims 9-11, Patrick does not specifically mention the wet compression percentage, dry compression percentage, or dry wet recovery percentage, but considering that the liner/insulator taught by the applied prior art is identical to the claimed liner/insulator in terms of structure and materials, it appears that the liner/insulator taught by the applied prior art inherently possesses the claimed properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 12, Patrick does not specifically mention using the liner/insulator as an automotive undercarpet, but since the claim fails to further structurally define the liner/insulator, it appears that the liner/insulator taught by the applied prior art can be considered an automotive undercarpet.

Regarding claims 13, Patrick discloses that the ribs may be made of scrap fibrous material (column 2, lines 47-53).

Regarding claims 15, Patrick discloses that the liner/insulator may be a nonlamine (see Figures).

9. Claims 1, 3, 5, 9-13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,497,950 to Haile in view of USPN 5,660,908 to Kelman.

Haile discloses that it is known in the headliner art to use thermoplastic bicomponent staple fibers (considered to read on the claimed thermoplastic staple fibers and the claimed thermoplastic bicomponent fibers) and glass staple fibers (see entire document including column



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1, line 45 through column 2, line 8, column 10, lines 49-58, column 12, lines 10-60, column 13, line 22-64, column 14, lines 27-50, and column 17, lines 52-57). Haile is silent with regards to specific headliner designs, therefore, it would have been necessary and thus obvious to look to the prior art for conventional headliner designs. Kelman provides this conventional teaching showing that it is known in the headliner art to use a liner/insulator design comprising a uniform base layer of fibrous material and a plurality of ribs of fibrous material extending from the base layer, the plurality of ribs being thermally bonded to the base layer (see entire document including column 1, lines 41-49, column 2, lines 38-47, column 3, lines 48-57, and Figure 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the headliner of Haile in the design disclosed by Kelman, motivated by the expectation of successfully practicing the invention of Haile and because it is within the general skill of a worker in the art to select a known headliner design on the basis of its suitability and desired characteristics.

Regarding claims 3, Haile discloses the use of polyester thermoplastic fibers (column 2, lines 26-39).

Regarding claims 5, Kelman discloses that the ribs extend parallel to one another (Figure 3).

Regarding claims 9-11, Haile does not specifically mention the wet compression percentage, dry compression percentage, or dry wet recovery percentage, but considering that the liner/insulator taught by the applied prior art is identical to the claimed liner/insulator in terms of structure and materials, it appears that the liner/insulator taught by the applied prior art inherently possesses the claimed properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 12, Haile does not specifically mention using the liner/insulator as an automotive undercarpet, but since the claim fails to further structurally define the liner/insulator, it appears that the liner/insulator taught by the applied prior art can be considered an automotive undercarpet.

Regarding claims 13, Haile does not specifically mention making the liner/insulator from scrap fibrous material, but Haile does disclose that the liner/insulator is made of a fibrous material. It is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article.

Regarding claims 15, Kelman discloses that the liner/insulator may be a nonlaminated (Figure 3).

10. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,497,950 to Haile in view of USPN 5,660,908 to Kelman as applied to claims 1, 3, 5, 9-13, 15 above, and further in view of USPN 5,892,187 to Patrick.

Kelman is silent with regards to the distance between ribs and the width of the ribs, therefore, it would have been necessary and thus obvious to look to the prior art for conventional distances between ribs and rib widths. Patrick provides this conventional teaching showing that it is known in the headliner art to vary the distance between ribs, and the width of the ribs, based on the desired sound or noise to be attenuated (see entire document including column 4, lines 52-67 and column 5, lines 44-57). Patrick specifically discloses that the width of the ribs may be about 22 mm or less (0.87 inches or less) and illustrates a distance between the ribs about equal to the specifically mentioned rib width (column 5, lines 44-57 and Figures 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the ribs spaced apart at least about 0.25 inches and with a width of between about 0.5 to about 3.0 inches, as taught by Patrick, motivated by the expectation of successfully practicing the invention taught by the prior art and based on the desired sound or noise to be attenuated.

11. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,497,950 to Haile in view of USPN 5,660,908 to Kelman as applied to claims 1, 3, 5, 9-13, 15 above, and further in view of USPN 5,885,390 to Alkire.

Haile discloses that it is known in the headliner art to use thermoplastic bicomponent staple fibers (considered to read on the claimed thermoplastic staple fibers and the claimed thermoplastic bicomponent fibers) and glass staple fibers (see entire document including column 1, line 45 through column 2, line 8, column 10, lines 49-58, column 12, lines 10-60, column 13, line 22-64, column 14, lines 27-50, and column 17, lines 52-57), but Haile does not appear to mention glass staple fibers and glass bicomponent fibers. Alkire discloses that it is known in the acoustical and thermal insulation art to include glass staple bicomponent fibers to reduce cost, process with less effort, and/or improve performance characteristics (see entire document including column 1, line 10 through column 2, line 42 and column 7, lines 5-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include glass staple bicomponent fibers, motivated by a desire to reduce cost, process with less effort, and/or improve performance characteristics, and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

***Response to Arguments***

12. Applicant's arguments filed 8/3/2007 have been fully considered but they are not persuasive or are moot in view of the new grounds of rejection.

The applicant asserts that Kelman fails to teach or suggest the claimed liner/insulator because Kelman does not thermally bond ribs to a uniform base layer. The examiner respectfully disagrees. The ribs of the headliner of Kelman are formed by heating and compressing a fibrous substrate to form a layer of ribs (back side of the substrate) thermally bonded to a uniform base layer (front side of the substrate) (see Figure 3). Although the method of making the liner/insulator is different than the claimed method, the resulting structure is the same. The applicant has failed to show, or attempt to show, that the structures are patentably distinct.

The applicant asserts that there is no motivation to combine references. The examiner respectfully disagrees. Haile is silent with regards to specific headliner designs, therefore, it would have been necessary and thus obvious to look to the prior art for conventional headliner designs. Kelman provides this conventional teaching showing that it is known in the headliner art to use a liner/insulator design comprising a uniform base layer of fibrous material and a plurality of ribs of fibrous material extending from the base layer, the plurality of ribs being thermally bonded to the base layer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the headliner of Haile in the design disclosed by Kelman, motivated by the expectation of successfully practicing the invention of Haile and because it is within the general skill of a worker in the art to select a known headliner design on the basis of its suitability and desired characteristics.

***Conclusion***

13. The following patent is cited to further show that USPN 5,885,390 relates to the headliner art:

USPN 5,980,680 to Miller (see Related U.S. Application Data and column 9, line 36)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/  
Primary Examiner, Art Unit 1794